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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,697	01/18/2002	William D. Castell	555255012306	1441

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EXAMINER

CHOW, MING

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 03/09/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

10/051,697

Applicant(s)

CASTELL ET AL.

Examiner

Ming Chow

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 January 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) 5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

*Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-4, drawn to a method of receiving voice mails, classified in class 455, subclass 412.1.
  - II. Claim 5, drawn to a method of conference calls, classified in class 370, subclass 260.

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because invention II (conference calls) does not require the particulars of the invention I. The subcombination has separate utility such as connecting conferencees and conference commands.

2. During a telephone conversation with Attorney David Cochran a provisional election was made without traverse to prosecute the invention of 10/051697, claims 1-4. Affirmation of this election must be made by applicant in replying to this Office Action. Claim 5 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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3. Applicant is advised that the reply to this requirement to be completed must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

### *Claim Objections*

4. Claim 4 recites the limitation "the caller-identification" in claim 1. There is insufficient antecedent basis for this limitation in the claim.

### *Drawings*

5. The drawings are objected to because proper legends, for example, items 110b, 130 Fig. 1, item 240 Fig. 2, item 312, 313, 316 Fig. 5 (this is not intended to be a complete listing), were missing. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase “the event” (line 5) is not clearly defined. It is unclear the claimed “the event” refers to which specific event among the claimed “a unified event listing” (line 3). Also, the phrase “the summary descriptor” (line 6) is not clearly defined. It is unclear the claimed “the summary descriptor” refers to which specific summary descriptor among the “a plurality of summary descriptor” (line 4). Also, the phrase “the interface” (line 9-10) is not clearly defined. It is unclear the claimed “the interface” refers to “a unified messaging interface” (line 1) or “a voice mail interface” (line 8).

7. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase “step 1” is not clearly defined. It is unclear what is referred by the claimed “step 1”.

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al (US: 6333973), and in view of Swartz et al (US:6330244).

For claim 1, regarding section (a), Smith et al teach on Fig. 7A event listing display, summary descriptor (item 7500 Fig. 7A), information elements (item 7400, Fig. 7A).

Regarding section (b), Smith et al teach on column 9 line 54-60 selects the voice mail icon (claimed “summary descriptor”).

Regarding section (c), Smith et al teach on Fig. 10 a voice mail interface with a plurality of voice mail actions.

Regarding section (d), Smith et al teach on column 9 line 62 the user presses one of the graphical controls.

Regarding section (e), Smith et al teach on column 9 line 62-65 translates the user’s action to control voice mail server.

Regarding sections (f), (g), Smith et al teach on column 10 line 1-2 voice mail server interprets the DTMF tone (claimed “receiving the voice mail command”) as an instruction to

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play back (claimed “executing an action associated with the received voice mail command”) the voice message.

Smith et al failed to teach sections (h), (i). However, Swartz et al teach on column 2 line 37-40 voice mails can be downloaded (claimed “performing an action”) from a voice mail server on a PBX (reads on claimed “circuit-switched connection”) to a hand-held terminal. When the voicemail is downloaded from the PBX a circuit-switched connection is established between the PBX and the hand-held terminal.

It would have been obvious to one skilled at the time the invention was made to modify Smith et al to have the sections (h), (i) as taught by Swartz et al such that the modified system of Smith et al would be able to support the voice mail action from the PBX via a circuit-switched connection to the system users.

Regarding claim 2, Smith et al in view of Swartz et al as stated in claim 1 above failed to teach “identifying the.....accepting the.....notification”. However, Swartz et al teach on column 7 line 28-32 telephone communication between mobile units via a PBX. Swartz et al teach on column 14 line 12-20 calling party address/name (claimed “caller-identification”) is displayed associated with an incoming call (reads on claimed “identifying the connection through a caller-identification”). The “auto answer” mode is the claimed “accepting the connection automatically”.

It would have been obvious to one skilled at the time the invention was made to modify Smith et al, Swartz et al to have the “identifying the.....accepting the.....notification” as taught by Swartz et al such that the modified system of Smith et al, Swartz et al would be able to

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support the identifying connection through a caller-identification and accepting the connection automatically to the system users.

Regarding claim 3, Smith et al teach on column 4 line 13-14 the Fig. 1 can be configured by using a PSTN (claimed "circuit-switched connection"). Smith et al teach on column 9 line 61-67 DTMF tones for voice mail actions.

Regarding claim 4, all rejections as stated in claim 1 above apply.

Further, regarding section 4(a), the request to playback a voice message is a request of a voice call as the message is played audibly. The user presses graphical control (column 9 line 62-63) without issuing a voice command reads on the claimed "a silent manner".

Regarding section 4(b), the generated DTMF tones (column 9 line 61-67) is private to the particular user device as it is not shared by any other user device.

### *Conclusion*

9. The prior art made of record and not replied upon is considered pertinent to applicant's disclosure.

- Helferich (US: 6097941) teaches user interface for voice message access.



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10. Any inquiry concerning this application and office action should be directed to the examiner Ming Chow whose telephone number is (703) 305-4817. The examiner can normally be reached on Monday through Friday from 8:30 am to 5 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached on (703) 305-4895. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service whose telephone number is (703) 306-0377. Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks**

**Washington, D.C. 20231**

**Or faxed to Central FAX Number 703-872-9306.**

Patent Examiner

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Ming Chow



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SUPERVISOR, PATENT EXAMINER  
TECHNOLOGY CENTER 2600

